

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on October 24, 2003, and the references cited therewith.

Claims 37-84 are added; as a result, claims 1-34, 36-84 are now pending in this application.

Objections to the Drawings and Specification

The page number and line numbers of various errors cited by the Examiner do not match Applicant's copy of the application. Perhaps the Examiner is referring to a different application. If the Examiner's copy of the present application as filed corresponds to the page and line numbers in the Office Action, Applicant respectfully requests that the Examiner provide a copy of the application as filed so that the page and line numbers of the above amendment can be corrected.

After a review of the specification and drawings, Applicant has amended the specification and drawings to correct errors in certain reference numerals and grammar. Reference numerals were added to or changed in the figures to match those of the text, and certain reference numbers were added to or changed in the text to match those of the Figures. The context of the original drawings and specification support these changes. No new matter is added.

Affirmation of Election

Restriction to one of the following groups of claims was required:

- I. claims 1-25 drawn to a method
- II. claims 26-36 drawn to an apparatus

As provisionally elected by Applicants representative, Charles A. Lemaire, on August 28, 2003, Applicant elects to prosecute the invention of Group I, claims 1-25.

The claims of the non-elected invention, claims 26-34, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

Double Patenting Rejection

Claims 1-12, 14, 16-25 were provisionally rejected under the judicially created doctrine of double patenting. Applicant respectfully points out that it is not the disclosure, but the subject matter of the claims that must be shown to be obvious.

Claims 1, 19 were rejected over claim 22 of U.S. Patent Application Serial No. 09/815,621. Claims 2-7, 22 were rejected over claim 30 of U.S. Patent Application Serial No. 09/815,621. Claims 8-12, 14 were rejected over claim 6 of U.S. Patent Application Serial No. 09/815,621. Claims 16, 23 were rejected over claim 23 of U.S. Patent Application Serial No. 09/815,621. Claims 17, 18 were rejected over claim 31 of U.S. Patent Application Serial No. 09/815,621. Claims 20, 21 were rejected over unspecified disclosure of U.S. Patent Application Serial No. 09/815,621. U.S. Patent Application Serial No. 09/815,621 is now abandoned, so these provisional rejections are moot. A Divisional application, Serial No. 10/693,817 was filed October 23, 2003, but is drawn to a method and apparatus for making a photovoltaic cell. Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 1, 3-7, 20 were provisionally rejected under the judicially created doctrine of double patenting over claims of U.S. Patent Application Serial No. 09/816,603, which is now allowed and the issue fee paid.

Claims 1, 20 were rejected over claim 16 of U.S. Patent Application Serial No. 09/816,603.

Claims 3-7 were rejected over claim 10 of U.S. Patent Application Serial No. 09/816,603. Applicant respectfully traverses, and points out that until otherwise allowable subject matter is indicated in the present case and the final claims of the present case can be compared to the allowed '603 case, presentation of a terminal disclaimer is premature. Applicant respectfully request that, once otherwise allowable subject matter is indicated, the Examiner then present any double-patenting rejection if then appropriate, and Applicant will consider the Examiner's assertions. A Terminal Disclaimer in compliance with 37 CFR 1.321(b)(iv) will be considered if appropriate to overcome these rejections.

§102 Rejection of the Claims

Claims 1-3, 8-11, 19, 20, 24, 25 were rejected under 35 USC § 102(b) as being anticipated by Bhattacharyya et al. (U.S. Patent No. 4,333,808). Applicant respectfully traverses. Bhattacharyya describes forming ultra-thin dielectric films (metal oxides and/or nitrides) for capacitors, wherein the adjacent conductive layers are rare-earth and transition metals such as tantalum, niobium, titanium, and vanadium. Dielectric films are used to separate plates of a capacitor. There is no teaching or suggestion in Bhattacharyya that any of the metal oxides discussed could or would act as an electrolyte.

In contrast, the present invention is drawn to a method for making a THIN-FILM BATTERY HAVING ULTRA-THIN ELECTROLYTE. An electrolyte of a thin-film battery, as is well known in the art, is a material that is resistive to the flow of electrons, but allows the flow of ions (such as lithium). The flow of such ions through the electrolyte between the cathode and anode causes electricity to flow through the circuitry connected to the terminals of the battery, since the electrons cannot flow through the electrolyte. Accordingly, the claims of the present invention are not anticipated by Bhattacharyya, and reconsideration of the rejection and an early indication of allowance of the claims are respectfully requested.

§103 Rejection of the Claims

Claims 4-7 were rejected under 35 USC § 103(a) as being unpatentable over Bhattacharyya et al. (U.S. Patent No. 4,333,808) in view of Veerasamy Patent Application publication 2001/0014398. Applicant respectfully traverses. Bhattacharyya et al. is discussed above and does not teach nor suggest depositing an electrolyte. Veerasamy on the other hand, describes placing a diamond-like carbon coating on silicon glass, in order to prevent water from reacting with the soda in the glass substrate, and does not teach nor suggest depositing an electrolyte. Further, Veerasamy describes only depositing carbon to obtain diamond-like materials when discussing ion energies. There is no suggestion that such techniques would work with depositing electrolyte materials (for example, such as LiPON). Further, Veerasamy does not disclose an ion-deposition energies less than 100 eV. Accordingly, the claims 4-7 of the present invention are not obvious Bhattacharyya in view of Veerasamy, and reconsideration of the rejection and an early indication of allowance of the claims are respectfully requested.

New claims

New claims 37-84 are added to more fully describe the claimed invention, and claims 37-80 are supported in the specification at page 85 line 15 to page 89. Claims 81-84 are supported by original claims 19-20. No new matter is added.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (952) 278-3501 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to deposit Account No. 502931.

Respectfully Submitted

MARK L. JENSON ET AL.

By their Representatives,

LEMAIRE PATENT LAW FIRM, PLLC
P.O. Box 11358
ST. PAUL, MN 55111
TELEPHONE: (952) 278-3500

Date

24 March 2004

By

Charles A. Lemaire

Charles A. Lemaire

Reg. No. 36,198

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelop addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24 day of March 2004.

Name: Charles A. Lemaire

Signature:

Charles A. Lemaire